No. 15-927

In the Supreme Court of the United States

SCA HYGIENE PRODUCTS AKTIEBOLAG
AND SCA PERSONAL CARE, INC.,

Petitioners,

v.

FIRST QUALITY BABY PRODUCTS, LLC,
FIRST QUALITY HYGIENE, INC.,
FIRST QUALITY PRODUCTS, INC., AND
FIRST QUALITY RETAIL SERVICES, LLC,

Respondents.

On Petition for a Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

BRIEF OF AMICUS CURIAE THE TORO COMPANY IN SUPPORT OF PETITIONERS

J. Derek Vandenburgh
Counsel of Record
Joseph W. Winkels
Alexander S. Rinn
CARLSON, CASPERS, VANDENBURGH,
LINDQUIST & SCHUMAN, P.A.
225 South Sixth Street, Suite 4200
Minneapolis, MN 55402
(612) 436-9600

Attorneys for Amicus Curiae
The Toro Company

Dated: February 19, 2016

2016 – Bachmann Legal Printing ■ (612) 339-9518 ■ 1-800-715-3582 ■ Fax (612) 337-8053

Table of Contents

Page

Table of Authorities iii

Interest of the Amicus Curiae 1

Summary of the Argument 1

Argument 3

I. SECTION 286 IS CLEAR ON THE TIMELINESS OF DAMAGES CLAIMS AND THERE IS NO NEED TO LOOK FOR FURTHER TIMELINESS LIMITATIONS IN § 282 3

A. The Patent Statute is Clear and Unambiguous on the Timeliness of Damages Claims 3

B. There is No Need to Look for Further Timeliness Limitations in § 282 5

C. The Six Year Laches Presumption is Incompatible with § 286 8

II. CONGRESS' SILENCE ON LACHES DOES NOT DEMONSTRATE ITS INTENT TO CODIFY THE EQUITABLE DOCTRINE'S APPLICATION TO PATENT DAMAGES 9

III. THE COURT'S PRECEDENT INSTRUCTS THAT LITTLE IF ANY WEIGHT SHOULD BE GIVEN TO FEDERICO'S COMMENTARY IN INTERPRETING THE PATENT STATUTE 12

IV THE MAJORITY'S POLICY CONCERNS ARE NOT JUSTIFICATIONS FOR LACHES AND/OR ARE ALREADY ACCOUNTED FOR BY § 286 15

V THIS CASE IS OF GREAT IMPORTANCE TO THE PATENT COMMUNITY 18

Conclusion 19

Table of Authorities

Cases **Page**

A. C. Aukerman Co. v. R. L. Chaides Constr. Co.,
960 F.2d 1020 (Fed. Cir. 1992) 7, 8

Astoria Fed. Sav. & Loan Ass'n v Solimino,
501 U.S. 104 (1991) 10

Bonito Boats v. Thunder Craft Boats,
489 U.S. 141 (1989) 16

Burns v. United States,
501 U.S. 129 (1991) 10, 11

C.R. Bard, Inc. v. M3 Sys.,
157 F.3d 1340 (Fed. Cir. 1998) 7

Caminetti v. United States,
242 U.S. 470 (1917) 3

Connecticut Nat'l Bank v. Germain,
503 U.S. 249 (1992) 3, 5

De Forest Radio Tel. Co. v. United States,
273 U.S. 236 (1927) 6

Garcia v. United States,
469 U.S. 70 (1984) 5, 13

Gustafson v. Alloyd Co.,
513 U.S. 561 (1995) 13

La. Public Serv. Comm'n v. FCC,
476 U.S. 355 (1986) 12

Lamie v. United States Tr.,
540 U.S. 526 (2004) 5

Petrella v. Metro-Goldwyn-Mayer, Inc.,
134 S. Ct. 1962 (2014) 9, 18

Potter v. United States,
155 U.S. 438 (1894) 5

Quern v. Mandley,
436 U.S. 725 (1978) 13

SCA Hygiene Products v. First Quality Baby Products, 807 F.3d 1311 (Fed. Cir. 2015) (en banc) ..... *passim*

Sullivan v. Finkelstein,
496 U.S. 617 (1990) 13

Util. Air Regulatory Group v. EPA,
134 S. Ct. 2427 (2014) 11

Whitman v. Am. Trucking Ass'ns,
531 U.S. 457 (2001) 12

Zenith Elecs. Corp. v. PDI Commun. Sys.,
522 F.3d 1348 (Fed. Cir. 2008) 7

Statutes

35 U.S.C. § 102(a) 17
35 U.S.C. § 102(g) 17
35 U.S.C. § 271(a) 6
35 U.S.C. § 271(e)(1) 16
35 U.S.C. § 282 ..... *passim*
35 U.S.C. § 282(b)(1) 6, 7
35 U.S.C. § 286 ..... *passim*

Rules

Supreme Court Rule 37.2(a) 1
Supreme Court Rule 37.6 1

Other

P J. Federico, Commentary on the New
Patent Act, 35 U.S.C.A 1 (West 1954) 2, 13, 15

Patent Law Codification and Revision:
Hearings on H.R. 3760 before Subcomm.
No. 3 of the H. Comm. on the Judiciary,
82d Cong. 34-40, 101-10 (June 1951) 14

Interest of the Amicus Curiae[1]

Amicus Curiae The Toro Company ("Toro") respectfully files this brief pursuant to Supreme Court Rule 37 in support of Petitioner. Toro files this brief for two reasons: (1) to further address salient statutory interpretation issues that have not been fully developed in the Petition that are important for the Court to consider; and (2) it, like other prominent patent holders and manufacturing companies, has an interest in making sure that the clear and unambiguous language of the patent statute actually does what it says. Toro's interest is based in part on the fact that it regularly has active patent litigation. Toro's interest is also based in part on the fact that one of its subsidiaries is currently a plaintiff in patent litigation where laches has been raised as a defense.

Summary of the Argument

The Federal Circuit in *SCA Hygiene Products v. First Quality Baby Products*, 807 F.3d 1311 (Fed. Cir. 2015) (en banc) held by a 6-5 majority that laches can bar legal relief in patent cases, despite longstanding precedent of this Court that the equitable defense of laches is unavailable when a statutory limitations period exists. The majority's holding was based on two flawed premises: (1) that a

---

[1] Amicus Curiae Toro timely notified counsel of record for all parties of its intent to file this brief, and counsel of record for all parties have consented to the filing of this brief. *See* Supreme Court Rule 37.2(a). No party's counsel authored this brief in whole or in part. No party or person other than amicus curiae contributed money to fund preparation or submission of this brief. *See* Supreme Court Rule 37.6.

single line in the post hoc commentary of a non-legislator (Federico's Commentary) demonstrates Congress' intent to codify laches in 35 U.S.C. § 282 of the 1952 Patent Act; and (2) that through its silence on the matter, Congress intended to codify lower court precedent allegedly suggesting that the equitable doctrine of laches could specifically bar legal relief in patent cases. In addition to those addressed by Petitioner, Amicus Curiae Toro addresses the following errors.

First, the timeliness of damages claims in patent cases is expressly and unambiguously addressed in 35 U.S.C. § 286. There is no legitimate basis to read in laches to the subtext of § 282 because that section has meaning without laches and reading laches into § 282 would run afoul of the plain language of that statutory section.

Second, because Congress clearly evinced its intent on the timeliness of damages claims in § 286, Congress' silence on laches cannot indicate its intent to codify allegedly clear lower court precedent applying the defense to bar legal relief.

Third, a single statement in post hoc commentary on the 1952 Patent Act written by a non-legislator is not legislative history, and does not shed light on what Congress thought it was voting for in 1952. The majority's reliance on Federico's Commentary to ascertain Congress' intention regarding laches is error.

Fourth, the policy concerns raised by the majority in support of its holding either do not in fact support its position when exposed to scrutiny, or

already are addressed by the timeliness provision of § 286.

This case is important to the patent community The Court already has received two petitions for writs of *certiorari* on the issue of laches in the wake of *SCA*. The business and legal community has an interest in knowing that the plain language of the patent statute will do the work it claims to do. The majority's holding in *SCA* undermines the predictability of the law

Argument

I. SECTION 286 IS CLEAR ON THE TIMELINESS OF DAMAGES CLAIMS AND THERE IS NO NEED TO LOOK FOR FURTHER TIMELINESS LIMITATIONS IN § 282

A. The Patent Statute is Clear and Unambiguous on the Timeliness of Damages Claims

Courts "should always turn first to one, cardinal canon [of construction] before all others" when interpreting a statute. *Connecticut Nat'l Bank v. Germain*, 503 U.S. 249, 253 (1992). In particular, courts are to "presume that a legislature says in a statute what it means and means in a statute what it says there. When the words of a statute are unambiguous, then, this first canon is also the last: judicial inquiry is complete." *Id.* at 253-54 (citations and internal quotation marks omitted); *see also Caminetti v. United States*, 242 U.S. 470, 485 (1917) ("It is elementary that the meaning of a statute must,

in the first instance, be sought in the language in which the act is framed, and if that is plain the sole function of the courts is to enforce it according to its terms.").

The only section in the patent statute that expressly addresses the effect of delay in bringing suit is 35 U.S.C. § 286, which states in unambiguous terms: "no recovery shall be had for any infringement committed *more than six years* prior to the filing of the complaint or counterclaim for infringement in the action." 35 U.S.C. § 286 (emphasis added). The meaning of § 286 with respect to the effect of delay on patent damages could not be more clear. As the en banc Federal Circuit held: "By its terms, § 286 is a damages limitation."[2] *SCA*, 807 F.3d at 1321. And by its express terms, § 286 envisions that a patentee may bring a suit "more than six years" after infringement begins. 35 U.S.C. § 286. In that case, pursuant to the statute, the patentee may only recover damages for infringement occurring within the six-year time period preceding commencement of suit. *See id.*

In contrast to § 286, nothing on the face of § 282 suggests any limitations on the timeliness of patent damages. Laches has never appeared in the patent statute and the legislative history of the patent act does not recognize case law on laches.

---

[2] The Federal Circuit also concluded that "because patent infringement is a continuous tort, there is no relevant functional difference between a damages limitation and a statute of limitations." *SCA*, 807 F.3d at 1321. Thus, there is "no substantive distinction material to the *Petrella* analysis between § 286 and the copyright statute of limitations considered in *Petrella*." *Id.*

SCA, 807 F.3d at 1337 (Hughes, T., dissenting). And as discussed below. laches does not even make logical sense in § 282. In the context of such facial clarity, judicial inquiry into the meaning of these statutory sections should proceed no further. *Connecticut Nat'l Bank*, 503 U.S. at 253-54. If other sources of meaning, such as legislative history, are to be consulted at all, "only the most extraordinary showing of contrary intentions from those data would justify a limitation on the plain meaning of the statutory language." *Garcia v. United States*, 469 U.S. 70, 75 (1984) (internal quotation marks omitted). For the reasons discussed by the dissent in *SCA*, the Petitioner, and here below, the majority's reliance on congressional silence and on a one line, post-enactment, statement by a non-legislator cannot qualify as the "extraordinary showing of contrary intent[]" that is required to limit the plain meaning of statutory language.

B. There is No Need to Look for Further Timeliness Limitations in § 282

The majority in *SCA* endeavored to find laches implicitly present in § 282, despite the clear statutory language of § 286, discussed above. *SCA*, 807 F.3d at 1321-23. Perhaps the only instance where this could be appropriate would be if § 282 (or a subportion thereof) would lack meaning without reading laches into that section. *See Potter v. United States*, 155 U.S. 438, 446 (1894) (statutory language "cannot be regarded as mere surplusage; it means something"); *cf. Lamie v. United States Tr.*, 540 U.S. 526, 536 (2004) (when two ways exist to read a statute, one in which a term is surplusage but the text is plain, and the other in which a term is nonsurplusage but the

text is ambiguous, courts "should prefer the plain meaning since that approach respects the words of Congress"). Here, § 282 does not require that laches hide in its subtext in order for the section to have meaning.

Though the majority does not specify where in § 282 it believes laches must reside, the only place laches could possibly exist is in § 282(b)(1). *SCA*, 807 F.3d at 1335 (Hughes, T., dissenting). That section states: "Defenses.—The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded: (1) Noninfringement, absence of liability for infringement or unenforceability." 35 U.S.C. § 282(b)(1).

Section 282(b)(1) has meaning and is well-understood in the law without needing to read-in laches. The first defense listed, noninfringement, clearly has meaning without reading-in laches: there is no infringement, for example, if one did not make, use, offer to sell, sell, or import any product or process meeting all the limitations of a claim of a patent. *See* 35 U.S.C. § 271(a).

The second half of § 282(b)(1) envisions two situations in which there may be infringement, but there is an inability to recover: "absence of liability for infringement" and "unenforceability." 35 U.S.C. § 282(b)(1). Like the "noninfringement" clause, it is similarly unnecessary to read-in laches to ensure this second clause has meaning. For example, regarding "absence of liability for infringement," one could infringe the claims of a patent, but be given permission to do so either by express or implied license. *E.g. De Forest Radio Tel. Co. v. United*

States, 273 U.S. 236, 241-42 (1927) (a license, express or implied, for a covered use of a patent is "a complete defense against a suit for infringement"). With a license, there would be infringement, but an absence of liability. Similarly, "unenforceability" has meaning without having to read-in laches. For example, a patent can be unenforceable if there was inequitable conduct at the patent office or in the instance of patent misuse. *E.g. Zenith Elecs. Corp. v. PDI Commun. Sys.*, 522 F.3d 1348, 1367 (Fed. Cir. 2008) (inequitable conduct); *C.R. Bard, Inc. v. M3 Sys.*, 157 F.3d 1340, 1372 (Fed. Cir. 1998) (patent misuse). Laches is unnecessary to give this clause meaning.

Not only is it unnecessary, reading laches into § 282(b)(1) would also run counter to the plain meaning of the statute. Laches clearly does not make logical sense under the "noninfringement" provision of §282(b)(1), because the typical case of laches presumes infringement. *See, e.g., A. C. Aukerman Co. v. R. L. Chaides Constr. Co.*, 960 F.2d 1020, 1034 (Fed. Cir. 1992) ("The six years for laches begins with a patentee's knowledge of infringement and counts forward."). Laches also does not make logical sense under the "absence of liability for infringement" or "unenforceability" provisions, because even when laches is found under existing law, a patentee typically can recover for post-suit damages. *SCA*, 807 F.3d at 1333 ("Whereas estoppel bars the entire suit, laches does not. a patentee guilty of laches typically does not surrender its right to an ongoing royalty."). In other words, laches does not result in an "absence of liability," nor does it render the patent "unenforceable." Although damages may be limited under the application of laches, damages are *not absent*, and the patent *remains enforceable* with

respect to post-suit damages and other equitable relief, such as the grant of an injunction.

C. The Six Year Laches Presumption is Incompatible with § 286

The six year laches presumption prescribed by the Federal Circuit is also incompatible with § 286. *See Aukerman*, 960 F.2d at 1037 (discussing the laches presumption). The laches "clock" starts to run when a patentee "knew or reasonably should have known" of the alleged action being accused of infringement. *Id.* at 1032. Thus, in the typical laches scenario, it would be almost impossible to take full advantage of the six year damages period expressly allowed for by § 286 without raising a presumption of laches. A patentee would have to file suit exactly six years after a company begins making, selling, using or importing a patented device (or process) to recover six years of past damages. Obviously, there is nothing wrong with filing suit before the six year mark. However, if a patentee filed suit six years and one day after commencement of infringement, laches would be presumed and the patentee may forfeit all past damages. It is a very strange thing for there to be such a stark discontinuity in one's ability to recover for a continuous tort. *See SCA*, 807 F.3d at 1321 ("patent infringement is a continuous tort"). The six year presumption makes it almost impossible to realize the full scope of § 286—an illogical result.

There are, of course, instances where an accused infringer's activity is sufficiently hidden such that it cannot be said that a patentee "should have known" about such activity, but such instances of secret infringement are by far the exception rather

than the rule. It is not reasonable to conclude that by expressly allowing for six years of past damages in § 286, Congress only intended that this apply to claims addressing secret or hidden infringement.

The patent statute is plain on its face regarding the timeliness of patent damages claims, there is no need to look for laches in § 282 to give the section meaning, reading-in laches to § 282 is inconsistent with the plain language of that section, and the six year laches presumption is incompatible with § 286. Nothing about the actual language of the patent statute suggests that laches can bar claims for legal relief.

II. CONGRESS' SILENCE ON LACHES DOES NOT DEMONSTRATE ITS INTENT TO CODIFY THE EQUITABLE DOCTRINE'S APPLICATION TO PATENT DAMAGES

The Court's clear and longstanding precedent instructs that, when Congress has chosen to codify a limitations period, laches cannot bar claims for legal relief. Pet'rs' Cert. Br. at 22; *see, e.g.*, *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 134 S. Ct. 1962, 1973-74. (2014). As discussed above, and as held by the Federal Circuit, § 286 is such a limitations period in the patent statute. *SCA*, 807 F.3d at 1321. Nonetheless, the Federal Circuit found that in 1952 Congress must have codified case law indicating that laches could preclude recovery of legal damages in patent cases. *Id.* at 1326-29. The sole basis for such a departure from this Court's precedent was congressional silence.

The Federal Circuit relied heavily on the canon of construction that "[w]hen a statute covers an issue previously governed by the common law. we must presume that Congress intended to retain the substance of the common law." *Id.* at 1324 (alteration in original). The majority notes that this applies only where "Congress has failed expressly or impliedly to evince any intention on the issue" addressed by the common law. *Id.* (quoting *Astoria Fed. Sav. & Loan Ass'n v. Solimino*, 501 U.S. 104, 110 (1991)). But on the timeliness of claims for past damages in patent cases, Congress explicitly stated its intention—and the Federal Circuit acknowledged this. *Id.* at 1321.

In light of the Court's decision in *Petrella*, the Federal Circuit in *SCA* recognized that "[i]n § 286, Congress provided a six-year time period for recovery of damages. § 286—a damages-barring time provision—invokes *Petrella*'s logic at least as much as, and perhaps more than, a statute of limitations." *SCA*, 807 F.3d at 1321. Thus, by the Federal Circuit's own acknowledgement, Congress has evinced its intention on the timeliness of damages claims in patent suits. This alone should have precluded the Federal Circuit from relying on the canon of construction that permits the codification of common law through Congressional silence. The majority should have found no use in analyzing the common law's application of laches to patent damages—Congress had spoken on the issue of timeliness via statute.

Moreover, while the Federal Circuit majority based its holding on congressional silence, this Court has cautioned that "not every silence is pregnant." *Burns v. United States*, 501 U.S. 129, 136 (1991).

> In some cases, Congress intends silence to rule out a particular statutory application, while in others Congress' silence signifies merely an expectation that nothing more need be said An inference drawn from congressional silence certainly cannot be credited when it is contrary to all other textual and contextual evidence of congressional intent.

Id. The inference from congressional silence in the majority's opinion is contrary to both the text and context of the patent statute.

First, as discussed above, the text of the patent statute is clear on the timeliness of patent damages claims. Section 286, the single clearest statement of congressional intent on the timeliness of damages claims, expressly limits past patent damages to six years and says nothing about laches. 35 U.S.C. § 286. Section 282 is facially silent on the issue. 35 U.S.C. § 282.

Second, even if some timeliness rule could be read-in to the subtext of § 282, the clear limitations period of § 286 would inform § 282. *SCA*, 807 F.3d at 1336 (Hughes, T., dissenting); *see Util. Air Regulatory Group v. EPA*, 134 S. Ct. 2427, 2441 (2014) ("[T]he words of a statute must be read in their context and with a view to their place in the overall statutory scheme."). Otherwise, the sub-textual rule of § 282 would conflict with the clear limitations period in § 286. As correctly noted by the dissent, "provisions of a statute should be read so as not to

create a conflict." *SCA*, 807 F.3d at 1336 (Hughes, T., dissenting) (quoting *La. Public Serv. Comm'n v. FCC*, 476 U.S. 355, 370 (1986)).

Furthermore, the dissent rightly notes that the House and Senate Reports from 1952 explain that the language of § 282 was meant to be changed to state defenses in more general terms, but the substance of § 282 was not to be materially changed. *SCA*, 807 F.3d at 1336 (Hughes, T., dissenting). The dissent also rightly notes that no pre-1952 act suggests that laches was meant to bar claims for legal relief, and "nothing in the legislative history reflects congressional recognition of any pre-1952 case law on the subject of laches, let alone approval of such case law as went beyond what the pre-1952 statutes authorized on their face." *Id.* at 1336-37. In light of the actual legislative history reflecting an intent to not materially change the substance of § 282, it does not make sense to take Congress' silence on laches as indicative of its intent to codify it in the subtext of § 282.

Congress' silence cannot be so powerful to override this Court's longstanding precedent and the text and context of the 1952 patent statute: Congress does not "hide elephants in mouseholes." *Whitman v. Am. Trucking Ass'ns*, 531 U.S. 457, 468 (2001).

III. THE COURT'S PRECEDENT INSTRUCTS THAT LITTLE IF ANY WEIGHT SHOULD BE GIVEN TO FEDERICO'S COMMENTARY IN INTERPRETING THE PATENT STATUTE

Petitioner correctly states that "the Federal Circuit relied heavily on a few words in the 1954

Federico Commentary" to support its holding that laches can bar legal damages in patent cases. Pet'rs' Cert. Br. at 21. The words of Federico's Commentary clearly are not the words of the patent statute, nor are they even legislative history. They are the post hoc commentary of a non-legislator.

After-the-fact statements by commentators "are not a reliable indicator of what Congress intended when it passed the law, assuming extratextual sources are to any extent reliable for this purpose." *Gustafson v. Alloyd Co.*, 513 U.S. 561, 579 (1995). Indeed, even "post hoc observations by a single member of Congress carry little if any weight." *Quern v. Mandley*, 436 U.S. 725, 736 n.10 (1978); *c.f. Garcia*, 469 U.S. at 76 (explaining that committee reports are the most authoritative legislative history, and eschewing casual statements of a single member of Congress). The relevance of legislative history to the interpretation of a statute, to the extent it has any, is to elucidate what members of Congress believed they were voting for. *Gustafson*, 513 U.S. at 579; *Sullivan v. Finkelstein*, 496 U.S. 617, 631 (1990) (Scalia, J., concurring in part).

By this standard, Federico's Commentary cannot be considered legislative history, and should be given little if any weight in interpreting the 1952 Patent Act. Mr. Federico was never a member of Congress, and his Commentary was not published until after the 1952 Patent Act was enacted. *See* Pet'rs' Cert. Br. at 21; P J. Federico, Commentary on the New Patent Act, 35 U.S.C.A 1 (West 1954). Federico's Commentary was not even available to members of Congress while they debated the 1952

Patent Act. It cannot inform what members of Congress believed they were voting on.

As the majority recognizes, Mr. Federico did provide testimony before the House Committee on the Judiciary in 1951 during the hearings on H.R. 3760—an early draft of the 1952 Act. *SCA*, 807 F.3d at 1322-23; *see* Patent Law Codification and Revision-Hearings on H.R. 3760 before Subcomm. No. 3 of the H. Comm. on the Judiciary. 82d Cong. 34-40, 101 10 (June 1951) (statements of P.J. Federico, Examiner in Chief, U.S. Patent Office) (hereinafter "Statements of Federico"). Unlike his Commentary, this testimony actually *was* available to members of Congress at the time they voted on the 1952 Act and might shed light on what members thought they were voting for. However, *Mr. Federico said nothing about laches during this testimony. See* Statements of Federico at 34-40, 101 10. He even addressed the very section of the bill that turned into § 282, but he merely said that the defenses listed therein were meant to be stated more generally without "changing the substance materially." *Id.* at 108.

Significantly, in other instances when the new Patent Act was meant to codify law that until that time had only existed as common law through the courts, Mr. Federico explicitly said so in this testimony to Congress. *Id.* at 38-39. For example, regarding the non-obviousness requirement of § 103, Mr Federico told the Committee: "Section 103 does something attempted for the first time in our statute, and that is to write down a condition which exists in the law and has existed for well over 100 years, but only by decisions of the courts." *Id.* at 38. In this actual legislative history of the 1952 Patent Act,

laches was not mentioned by Mr. Federico, nor did he refer to any intent to codify common law relating to laches.

Mr. Federico was undoubtedly influential in drafting the 1952 Patent Act, but his post hoc Commentary sheds no light on what members of Congress actually thought they were voting for. At best, his Commentary represents his own opinions about what the law was meant to do—this is not reflective of the intent of Congress. *See* Federico Commentary at "Author's Note" ("[I]t should be understood that the paper contains some opinions and views of the writer even though not always labeled as such.") In light of the plain text of the statute, and especially in light of Mr. Federico's testimony to members of Congress during their consideration of the bill, it is erroneous for the majority to essentially base its holding in *SCA* on a single statement in Federico's post hoc Commentary.

IV THE MAJORITY'S POLICY CONCERNS ARE NOT JUSTIFICATIONS FOR LACHES AND/OR ARE ALREADY ACCOUNTED FOR BY § 286

After studying Federico's Commentary and the congressional silence on laches, the majority in *SCA* justified its holding that laches can bar legal relief despite the damages limitation of § 286 based on several policy considerations. As noted by the dissent, it is the job of Congress to account for competing policy concerns when crafting patent legislation. *SCA*, 807 F.3d at 1342 (Hughes, T., dissenting). It is not the role of the Federal Circuit to undermine Congress' judgment, by shaping the law

based on its own, current assessment of the policy landscape. *Id.; see Bonito Boats v. Thunder Craft Boats*, 489 U.S. 141, 143, 163-68 (1989) (questioning the Federal Circuit's analysis that the policies behind federal patent laws were not threatened by a state law prohibiting direct molding for the duplication of unpatented articles, noting that Congress should make such determinations, and despite consideration of similar bills, Congress had refused to enact such a law).

In any event, each of the policy concerns raised by the majority are either not really justifications for laches, or they already are accounted for by the damages limitation in § 286. First, the majority notes that companies (such as in the medical device industry) may spend large sums of money to develop products and shepherd them through the regulatory process only to have a patentee sue six years later seeking the most profitable six years of revenues. *SCA*, 807 F.3d at 1330. The theory here appears to be that if the company were only told of its infringement sooner, such damages could be avoided.

This example is an illogical justification for laches. As an initial matter, in such an expensive endeavor a company is likely to undertake a patent clearance process. In any event, companies do not regularly broadcast their research and development efforts to the world. And § 271(e)(1) of the patent statute states that it is not an act of infringement to make, use, offer to sell, or sell a patented invention solely for uses reasonably related to obtaining necessary regulatory approval. 35 U.S.C. § 271(e)(1). By the time a medical device company. for example, brings a product to market that might actually

constitute patent infringement, the company already has invested large sums of money—suing within six years of the product's introduction to market does not change that fact.

Second, the Federal Circuit alludes to the large volume of suits brought by non-practicing entities, noting that "it is often impractical for companies to determine which claims have merit." *SCA*, 807 F.3d at 1330. This concern is simply irrelevant to laches. Laches addresses the timeliness of claims, not their merits.

Third, the majority is simply wrong when it claims that "[i]ndependent invention is no defense in patent law, so without laches, innovators have no safeguards against tardy claims." *Id.* Innovators have § 286, which limits the extent to which a patentee can recover for claims filed more than six years after infringement began. Additionally. independent invention can act as a defense to the extent such acts qualify as invalidating prior art under 35 U.S.C. § 102(a).[3]

Finally, the majority notes that amici in the en banc case "overwhelmingly support[ed] retaining laches in patent law." *SCA*, 807 F.3d at 1340. It is true that more amici supported retaining laches than not, but many of those amici were companies who are regular patent infringement defendants. It is not

---

[3] Prior to the enactment of the American Invents Act (AIA) in 2011, 35 U.S.C. § 102(g) also allowed for independent invention to serve as a defense. The concept codified in prior § 102(g) has limited relevance under the AIA's first-to-file rule, but it was present in the 1952 Act and existed for more than sixty years until the enactment of the AIA.

surprising that such companies would support a measure that could absolve them of some liability. Notably, however, two prominent amici with a much more disinterested view based simply on a reading of the law (the American Intellectual Property Law Association and a group of prominent patent law professors), argued that laches should not be found to bar claims for legal relief in light of *Petrella*. *See* Brief for Am. Intellectual Property Law Assoc. as Amicus Curiae Supporting Neither Party, *SCA Hygiene Prods v. First Quality Baby Prods.*, 807 F.3d 1311 (Fed. Cir. 2015) (No. 2013-1564); Brief for Law Professors as Amici Curiae Supporting Appellants, *SCA Hygiene Prods v. First Quality Baby Prods.*, 807 F.3d 1311 (Fed. Cir. 2015) (No. 2013-1564).

V THIS CASE IS OF GREAT IMPORTANCE TO THE PATENT COMMUNITY

The Federal Circuit sitting en banc decided the *SCA* case by the narrowest of margins: 6-5. There was sharp disagreement between the majority and the dissent. Though the Federal Circuit has spoken on the applicability of laches to bar legal relief, many in the broader patent community still seek clarity in light of the Court's ruling in *Petrella*. Notably, the Court already has received two petitions for writs of *certiorari*, challenging findings of laches in light of *Petrella*. Pet'rs' Cert. Br.; Petition for Writ of Certiorari, Medinol Ltd. v. Cordis Corp., No. 15-998 (2016). The regularity with which laches is claimed as a defense in patent cases suggests that that Court should expect many more similar petitions.

Finally, the broader patent community has two additional general interests in the Court hearing this

case. First, the patent community has an interest in knowing that the plain language of the patent statute will do the work it claims to do. In other words, they have an interest in the predictability of the patent law The Federal Circuit's holding in *SCA* undermines the predictability of the law

Second, the broader patent community has an interest in making sure that the patent law remains as uniform as possible with the broader civil, common law This Court routinely warns against patent exceptionalism in the civil law for good reason. When the patent laws reflect the tried-and-true principles of the broader civil law, innovators and business decision makers have more trust in the usefulness and validity of the patent system, and both parties and legal practitioners can rely on predictability in the law

Conclusion

For all these reasons, the Court should grant SCA's petition for a writ of *certiorari*, and reverse the Federal Circuit's en banc decision.

Respectfully submitted,

J. Derek Vandenburgh
(*Counsel of Record*)
Joseph W Winkels
Alexander S. Rinn
CARLSON, CASPERS, VANDENBURGH,
LINDQUIST & SCHUMAN, P.A.
225 South Sixth Street, Suite 4200
Minneapolis, MN 55402
Tel: 612-436-9600
Fax: 612-436-9605
E-mail:
dvandenburgh@carlsoncaspers.com

Counsel for Amicus Curiae
The Toro Company

Dated: February 19, 2016